



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,620	09/02/2003	Jack A. Marmorstein	028788.0102-US00	1037

26853 7590 06/21/2006

COVINGTON & BURLING
ATTN: PATENT DOCKETING
1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2401

EXAMINER

MOSSER, KATHLEEN MICHELE

ART UNIT PAPER NUMBER

3715

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

c

Office Action Summary	Application No. 10/652,620	Applicant(s) MARMORSTEIN ET AL.	
	Examiner Kathleen Mosser	Art Unit 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| <ul style="list-style-type: none"> 1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date <u>03/22/06</u>. | <ul style="list-style-type: none"> 4) <input type="checkbox"/> Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____ 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____ |
|--|--|

DETAILED ACTION

In response to the amendment filed 03/22/2006, claims 1-86 and newly added claims 87-92 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-25, 27, 29-41, 43-66, 72, 73, and 75-90 are rejected under 35 U.S.C. 101 because the claimed invention lacks the claimed invention is directed to non-statutory subject matter. Regarding claims 1-22 for a method claim to be statutory it must result in a practical application of an otherwise abstract idea. To show this the method must either (a) result in a physical transformation or (b) otherwise produce a useful, concrete and tangible result. In the current claims the method is only directed to the displaying/presenting of information without any alteration of the data, steps performed on the data or calculation. As the methods deal completely with data there cannot be a physical transformation which transforms an article or physical object to a different state or thing. The claims assert a credible utility are "useful" in that they may be used as an educational aide. However, the claims are not concrete or tangible. The last feature of independent claim 1 asserts that the first and second descriptions of the event provide a language immersion environment for language instruction. In order to be concrete the must be assured, or repeatable with a reasonable expectation of success. The claimed steps of presenting information in various formats does not necessarily or reasonable result in the creation and therefor creation of a language immersion environment suitable for language instruction. Further, the preamble of the claim states that the method is intended for language instruction. Merely presenting information does not convey instruction or learning capabilities. There is no reasonable expectation that a user of the method would be able to learning a language merely through having the data presented to them. As such, the method fails to show repeatability with a reasonable expectation of success, and is thus not considered to be concrete. In order for a method to be tangible it must produce a real-world result that is appreciable to the user. The claimed steps are simple the display of data, there

Art Unit: 3715

is no algorithm, calculation, or processing of the data which results in an appreciable change or modification of the data. Simply displaying data absent any other modifications or calculations does not constitute an appreciable result or a real-world application of otherwise abstract ideas. The same applies to the method associated with claims 43-64, although this method is recorded on a computer readable medium, the same conditions must be met. Newly added claims 87 and 89 are rejected for the same reasons.

Regarding claim 23 and its dependents, the invention of the system includes a display screen which displays several elements. Each of the elements appears to be nothing other than data, which in itself is only printed matter. In this embodiment the substrate is the display screen. A mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *in re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *EX part Gwin*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967). In the present application, the claimed printed matter set forth a mere arrangement of printed matter that is not functionally related to the substrate and, therefore, does not distinguish the invention from prior art in terms of patentability. Although printed matter must be considered, in this situation, it is not entitled patentable weight. The printed matter claimed herein conveys no meaningful information in regard to the substrate, which they are arranged on and do not require any size relationship of the substrate, and do not require any particular substrate to effectively convey the information. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is no-statutory subject matter. The same applies to claim 65 and its dependents, where the multimedia presentation means is merely a computer display. Newly added claims 88 and 90 are rejected for the same reasons.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 3715

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 23-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Regarding claim 23, the claim although recited as a structural component is analogous to a single means claim (i.e. a description presentation apparatus), where a means recitation does not appear in combination with another recited element of means, is subject to undue breadth rejection. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983). It is noted that in the specification the apparatus is a computer screen, or any other display, and the scope of the claimed presentation apparatus, the only means in the claim, covers every conceivable structure for achieving the stated property (displaying information on a screen), is held non-enabling for the specification discloses at most only those known to the inventor. Dependent claims 24-42 do not correct this issue or add other structural elements to the claim and are rejected for the same reasons.

3. Claims 87-90 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite the negative limitation of "wherein neither the first description or the second description is a script of the other of the first description and the second description". The specification as originally filed does show no constraints or limitations as to what the first and second descriptions may or may not be. There is no implied or explicit teaching that the first description cannot be a transcript of the other, or that such a feature is not preferred to other alternatives disclosed. As such, adequate support for the negative limitation is not provided.

Art Unit: 3715

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-12, 23, 24, 29, 31, 43-54 and 65-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Bishop (US 5810599). Bishop teaches a display presentation display, specifically a computerized system with a video display and computer readable medium, which performs the steps of: presenting a first audio description of an event responsive to a first perspective (the audio visual work,); and presenting a second text description of the event responsive to a second perspective (the transcript) wherein the first and second description of the event are in the same language, as in **claims 1, 23, 43 and 65**. The event is displayed as an audio-visual work which is by definition a visual representation of the event, as in **claims 2, 24, 44, and 66**. Regarding **claims 3-9, 45-51 and 67-73**, the audio-visual work presents the audio components of the claims and the transcript presents the textual components of the claims, see at least col. 8: 40-6. These pieces are displayed on a computer monitor and simultaneously, as in **claims 10, 11, 29, 52, 53, 74 and 75**. The event includes and interaction between a first individual and a second (**claims 12, 31, 54, and 76**), as is shown in at least col. 9: 54 – col. 10: 18.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 91 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishop (US 5810599). Bishop teaches all features of the claimed invention as shown above but fails to teach that the

Art Unit: 3715

description presentation apparatus is one of a cellular phone, a PDA, a television display or a game console. Applicant teaches the equivalence of these items in paragraph 28 of the specification as originally filed. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to replace the computer display of Bishop with a television screen or the computer system with a game console, because the applicant has not disclosed that the specific display provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art would further have expected the invention of Bishop and that of the claimed embodiments to perform equally well as all the displays are recognized equivalents in performing the function of displaying information.

Response to Arguments

6. Applicant's arguments filed 03/22/2006 have been fully considered but they are not persuasive.

Rejections under 35 USC §101

The applicant generally asserts that the claims are statutory because they relate to language instruction. The examiner has further defined the rationale for the rejection of the claims and further addressed the amendments to the claims and the reasons as to why they fail to overcome the previous rejections in the above rejection of the claims.

Rejections under 35 USC §112, first paragraph

The examiner has removed claim 43 and its dependents from the rejection. These claims were accidentally listed in the previous office action. Although the applicant has amended claim 23 to recite that the apparatus includes a display screen, the claim still only contains a single component, the display screen. The recitation of stating that the apparatus comprises a display screen still covers every conceivable possibility of the any device with a display and fails to address the rationale for the previous rejection.

Art Unit: 3715

Rejections under 35 USC §102

Applicant asserts that the audio-visual work of Bishop can not be interpreted as "a first text or audio description of an event responsive to a first perspective" because the recitation of "text or audio" precludes the further inclusion of visual images. Firstly, the Bishop invention presents audio as a part of the audio-visual presentation, and thus meets the limitation of the claim. Secondly, the claims are written in "comprising" language, so the inclusion of additional features in the prior art is not precluded by the absence of them in the instant claim. Lastly, the applicant further includes the visual presentation of the event in at least claim 2. Were this feature explicitly excluded from the invention by the language of the claims, the inclusion of such a feature in claim 2 would be improper. Each of new claims 87-92 have been addressed above.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

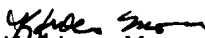
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Mosser whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

Art Unit: 3715

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Kathleen Mosser
Primary Examiner
Art Unit 3715

June 9, 2006